

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION**

KIRSCH RESEARCH AND
DEVELOPMENT, LLC,

Plaintiff,

v.

IKO INDUSTRIES, INC.;
IKO INDUSTRIES LTD.,

Defendants.

Civil No. 6:20-cv-00317-ADA

JURY TRIAL DEMANDED

PATENT CASE

**DEFENDANTS' NOTICE OF SUPPLEMENTAL AUTHORITY RE CLAIM
CONSTRUCTION AND IN SUPPORT OF ITS PENDING MOTIONS**

Pursuant to the Court's Order Governing Proceedings in Patent Cases, Defendants IKO Industries, Inc. and IKO Industries LTD ("Defendants") respectfully submit this Notice of Supplemental Authority relevant to the construction of disputed terms of U.S. Patent No. 6,308,482 (the "'482 Patent") and regarding two of Defendants' motions pending before the Court.

An EDTX Court Has Issued a *Markman* Order Regarding the '482 Patent

On July 19, 2021, Judge Schroeder in the Eastern District of Texas, Texarkana Division, issued an Order construing disputed terms of the '482 Patent. *Kirsch Research and Development, LLC v. DuPont de Nemours, Inc. et al.*, No. 5:20-CV-00057-RWS (E.D. Tex.), Dkt. 276. The authority is attached as Exhibit A to this Notice.¹ The Order construes the disputed terms as

¹ A Notice of Supplemental Authority is procedurally proper because the Court held a *Markman* hearing on April 29, 2021, but no claim construction order has been issued in this case or any case involving the '482 Patent. Moreover, the Court's July 19, 2021, order in the related BlueLinx matter suggests that it is still in the pre-*Markman* phase. *See Exhibit B at 8* (denying BlueLinx's direct infringement challenge as "untimely" because "BlueLinx asks the Court to engage in pre-*Markman* claim construction and resolve that construction in its favor, this is premature."). To the extent the Court determines that claim construction in IKO's case is post-*Markman*, Defendants reserve the right to file a Motion for Reconsideration.

follows:

'482 Patent Claim Term	Construction
Preamble: “A roofing underlayment positioned between a roof support structure and an overlayment”	The entire preamble of claim 1 of the '482 patent is limiting. (Dkt. 276, at 44)
“waterproofing” / “waterproof”	“preventing liquid water from passing through” / “prevents liquid water from passing through” (Dkt. 276, at 48)
“weather-resistant barrier”	“barrier for preventing liquid water and other external weather elements from passing through” (Dkt. 276, at 54)
“cross-laminated strands”	“strands bonded together where some of the strands are oriented at right angles to other strands” (Dkt. 276, at 58)
“slip-resistant material”	“polypropylene or similar material that provides slip-resistance in wet or dry conditions” (Dkt. 276, at 62)
“by extrusion lamination”	“by being melted in an extruder, and forced onto the reinforcing scrim through a die of the extruder” (Dkt. 276, at 67)
“the thermoplastic layer may include polyethylene or polypropylene” / “the thermoplastic layers may include polyethylene or polypropylene”	“the thermoplastic layer includes at least polyethylene or polypropylene” / “the thermoplastic layers includes at least polyethylene or polypropylene” (Dkt. 276, at 70)

The Court Granted Defendant BlueLinx’s Motion to Dismiss Kirsch’s Induced and Willful infringement Claims

This Court recently granted Defendant BlueLinx Corporation’s motion to dismiss Kirsch’s claims of induced and willful infringement under Rule 12(b)(6). *Kirsch Research and Development, LLC v. BlueLinx Corporation*, No. 6:20-cv-00316-ADA (W.D. Tex.), Dkt. No. 68 at 8. The authority is attached as Exhibit B to this Notice.

Defendants in this case filed a substantively identical motion to dismiss pursuant to Rule 12(b)(6) on September 17, 2020, which they renewed on October 15, 2020. *See* Dkt. Nos. 19, 30, 35, 37. Defendants' motion remains unresolved.

Four Petitions for IPR Have Been Filed Against the Patent-in-Suit

Two additional petitions for *Inter Partes* Review ("IPR") have been filed against the expired asserted patent in this case—U.S. Patent No. 6,308,482 (the "'482 Patent")—both of which Kirsch failed to bring the attention of the Court as required by this Court's Order Governing Patent Proceedings. *See* OGP, Version 3.4, General Issues, ¶ 5. On June 24, 2021, Petitioner Atlas Roofing Corporation filed a petition in IPR2021-01181. Also on June 24, 2021, Petitioner Epilay, Inc. filed a petition in IPR2021-01183.

There are now two instituted IPRs and two petitions for IPR pending against the '482 Patent. One of the instituted IPRs is statutorily required to result in a Final Written Decision before the scheduled trial date of March 14, 2022. The table below summarizes the four pending proceedings:

IPR No.	Petitioner	Filing Date	Institution Date	Final Written Decision
IPR2020-01389	Owens Corning Roofing & Asphalt, LLC	Jul. 29, 2020	Feb. 18, 2021	Feb. 18, 2022
IPR2021-00192	GAF Materials LLC	Nov. 10, 2020	May 25, 2021	May 25, 2022
IPR2021-01181	Atlas Roofing Corporation	Jun. 24, 2021	Pending	Pending
IPR2021-01183	Epilay, Inc.	Jun. 24, 2021	Pending	Pending

More than ten months ago, Defendants filed a Motion to Stay Pending Resolution of the Related ITC Proceeding and/or *Inter Partes* Review of the Patent-In-Suit. *See* Dkt. No. 22 (September 17, 2020 "Motion to Stay"). Multiple district courts have elected to stay the cases

involving the '482 Patent in view of one or more of these pending IPRs. *See* Dkt. Nos. 49, 63. Defendant's motion remains unresolved.

Dated: July 22, 2021

FISH & RICHARDSON P.C.

By: /s/ Michael R. Ellis
Neil J. McNabnay
njm@fr.com
Texas Bar No. 24002583
Ricardo J. Bonilla
Texas Bar No. 24082704
rbonilla@fr.com
Michael R. Ellis
Texas Bar No. 24039623
ellis@fr.com

FISH & RICHARDSON P.C.
1717 Main Street
Suite 5000
Dallas, TX 39007
(214) 747-5070 (Telephone)
(214) 747-2091 (Facsimile)

Attorneys for Defendants
IKO Industries, Inc. and IKO Industries Ltd.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of this document has been served on July 22, 2021, to all counsel of record who are deemed to have consented to electronic service via the Court's CM/ECF system.

/s/ Michael R. Ellis
Michael R. Ellis